

Cardinal et al. disclose coating thermoplastic ester ether elastomers at an extrusion temperature of 240°C.

Claim 10 recites a method of forming a continuous film layer of a thermoplastic composition onto a substrate, the method including the steps of:

- a) providing a molten thermoplastic composition;
- b) advancing a substrate along a path;
- c) dispensing a continuous film of the thermoplastic composition from a coating device at a coating temperature wherein the thermoplastic composition has a complex viscosity of less than about 500 poise at about 1000 radians/seconds at the coating temperature and a complex viscosity ranging from about 100 poise to about 1,000 poise at about 1 radian/second at the coating temperature;
- d) suspending the film between the coating device and the substrate; and
- e) contacting the film with the advancing substrate wherein the thermoplastic composition is released from the coating device at a temperature of less than about 160°C.

Maletsky et al. mention that their composition was extruded onto a substrate. Maletsky et al. do not, however, teach or suggest which extrusion method was used. Numerous extrusion methods exist. There is nothing in Maletsky et al. that directs the skilled artisan to select any particular extrusion method –let alone the extrusion method of Cardinal et al. Moreover, it is undisputed that neither Cardinal et al. nor Maletsky et al. teach or suggest the use of the Cardinal et al. extrusion method for applying the composition of Maletsky et al. Instead, the Office action relies upon an assumption that it would have been obvious to employ “conventional coating techniques . . . [for applying] thin films to nonwovens.” Office Action, page 3. The sounds very much like an “obvious to try” standard. Obvious to try is not the test of obviousness under 35 U.S.C. § 103. In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987). The standard under 35 U.S.C. § 103, as well established by legal precedent, is that there must be some teaching, suggestion or motivation for making the proposed combination, and that teaching, suggestion or motivation cannot come from Applicants’ specification. See, e.g., In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138

(Fed. Cir. 1985). Here there is no such teaching, suggestion or motivation for making the proposed combination.

It is well known that the viscosity of a composition has a direct bearing on the extrusion methods that are available for use with the composition and that viscosity is primary property in selecting an appropriate extrusion method for the composition. See, Declaration of Mark Kroll, paragraph 4 (attached at Tab 1). Maletsky et al. recognize that the coating temperature of the composition is directly proportional to the viscosity of the composition selected. See, Maletsky et al., column 5, lines 54-56 (“The coating temperature, which falls within the range of from 300°F to about 500°F, is directly proportional to the viscosity of the composition selected.”). Maletsky et al. further disclose that for “superior results it is recommended that the coating temperature for a viscosity in the range of from 5,000 to 11,000 cps be between 162.8°C and about 176.7°C.” The only example composition prepared by Maletsky et al. has a viscosity of 11,000 cps (110 poise) at 162.8°C. Maletsky et al. disclose that for compositions having a viscosity of 11,000 cps, the preferred coating temperature is from 162.8°C and about 176.7°C. Cardinal et al. disclose that their extrusion temperature is 240°C. Cardinal et al. do not teach or suggest that their coating methods would be suitable for a composition having a viscosity of 11,000 cps at 162.8°C. Moreover, there is nothing in Cardinal et al. that teaches or suggests that the compositions of Maletsky et al. would be suitable for application using the methods of Cardinal et al. In particular, the Cardinal et al. compositions are thermoplastic polyester elastomers. In addition, there is nothing in Cardinal et al. that teaches or suggests that the properties of Cardinal et al.’s thermoplastic polyester elastomers that make them suited to the Cardinal et al. method are sufficiently similar to the properties of the Maletsky et al. composition so as to render the Maletsky et al. composition suitable for application using the Cardinal et al. method. Moreover, Hytrel G3548W has a viscosity that is at least an order of magnitude greater than the viscosity of the Example composition of Maletsky et al. See, e.g., Hytrel product literature (attached at Tab 2). In particular it appears that Hytrel G3548W has a viscosity of about 130 Pa sec (i.e., 1300 poise) at 1000 rad/second at 190°C (see, Figure 1, Hytrel product literature). The viscosity of Hytrel G3548W does not appear to be measurable at 1 rad/second, however, continuing a line along the slope of the Hytrel

G3548W curve it appears that the viscosity would be about 2000 Pa sec (i.e., 20,000 poise) 1 rad/second. The viscosity of the example composition of Maletsky et al., in contrast, is 110 poise at an unknown rate at 162.8C. Accordingly, the skilled artisan would not think to use the method of Cardinal et al. to apply the composition of Maletsky et al. In light of the above, Applicants submit that the rejection of claim 10 under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. is unwarranted and should be withdrawn.

Claims 2-6, 8, 9, 11, 12, 33-36, 38-42, 44 and 46-56 are patentable under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. for at least the same reasons set forth above in distinguishing claim 10.

Claim 55 is further distinguishable over the proposed combination of Maletsky et al. and Cardinal et al. for at least the following additional reasons. Claim 55 recites suspending a continuous film such that it builds in viscosity and cohesive strength. Neither Maletsky et al. nor Cardinal et al. nor any combination thereof teaches or suggests suspending a continuous film such that it builds in viscosity and cohesive strength. The proposed combination thus lacks a required element of claim 55. Applicants submit, therefore, that the rejection of claim 55 under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. is unwarranted and request that it be withdrawn.


The remaining rejections, i.e., claim 7 under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. and further in view of EP 295,694, and claims 47-51, 53 and 54 stand rejected under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. and further in view of some unknown allegedly admitted prior art, are directed to claims that depend either directly or indirectly from claim 10 and are based upon the above-refuted premise that claim 10 is obvious under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al.. Since the premise on which these remaining rejections are based has been refuted, these remaining rejections cannot stand. Accordingly, Applicants request that the rejection of claim 7 under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. and further in view of EP 295,694, and claims 47-51, 53 and 54 stand rejected under 35 U.S.C. § 103 over Maletsky et al. in view of Cardinal et al. and further in view of some unknown allegedly admitted prior art be withdrawn.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. The Examiner is invited to telephone the undersigned if a teleconference interview would facilitate prosecution of this application.

Please charge any additional fees or credit any overpayment to Deposit Account No. 501,171.

Respectfully submitted,

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